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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,404	11/25/2003	Takuya Tamatani	14539-004012	1646
26161 7590 01/08/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER OUSPENSKI, ILIA I	
			ART UNIT	PAPER NUMBER
			1644	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/08/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/721,404

Applicant(s)

TAMATANI ET AL.

Examiner

ILIA OUSPENSKI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53 - 59, 64 - 66, and 68 - 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53 - 59, 64 - 66, and 68 - 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment/remarks, filed 10/13/2006, are acknowledged.

Claims 1 – 52, 60 – 63, and 67 have been cancelled.

Claims 53 – 59, 64 – 66, and 68 – 69 are pending.

2. This Office Action will be in response to applicant's amendment and arguments, filed on 10/13/2006.

The rejections of record can be found in the previous Office Action, mailed on 07/17/2006.

The text of those sections of Title 35 USC not included in this Action can be found in a prior Office Action.

3. Regarding Applicant's claim for domestic priority under 35 U.S.C. 120, the following is noted.

Applicant argues that support for the claimed limitations of steps of “contacting the polypeptide with a test substance” and “determining whether the test substance interacts with the polypeptide” is implicit in the disclosure of use of the polypeptides in searching for molecules that interact with the cell surface molecules of the invention.

It is acknowledged that in view of the disclosure of use of the polypeptides in searching for molecules that interact with them, it would be obvious to one of ordinary skill in the art that the “use” may include the steps of “contacting the polypeptide with a

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test substance” and “determining whether the test substance interacts with the polypeptide.” However, these steps are not implicit in the disclosure, because, as one of ordinary skill in the art is aware, searching for molecules that interact with a polypeptide does not necessarily include the steps of contacting and determining, because the searching can be done, for example, *in silico*, wherein the searching is performed by a computer algorithm.

Obviousness is not the standard for the addition new limitations to the disclosure as filed. Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. Lockwood v. American Airlines Inc., 41 USPQ2d 1961 (Fed. Cir. 1977).

Consequently, it is maintained that the instant claims 53 – 59, 64 – 66, and 68 – 69 are entitled to the earliest priority of the filing date of application USSN 10/301,056, i.e. 11/21/2001.

4. Claims 53 – 59, 64 – 66, and 68 – 69 stand rejected under **35 U.S.C. 103(a)** as being obvious over Tamatani et al. (US Pat. Pub. No. 2002/0115831, published 08/22/2002; see entire document).

Applicant’s arguments have been fully considered but have not been found convincing.

Applicant argues that the reference is a publication of a priority document of the instant application, and as such, does not constitute prior art against the instant claims.

This is not found convincing, because, as addressed below, the instant claims are not deemed to be entitled to the priority date of prior applications. At the same time, the instant claims are obvious in view of the disclosure of the priority applications.

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Therefore, the rejection of record is maintained for the reasons of record, as it applies to the amended claims. The rejection of record is incorporated by reference herein, as if reiterated in full.

5. Claims 53 – 59, 64 – 66, and 68 – 69 stand provisionally rejected on the ground of nonstatutory **obviousness-type double patenting** as being unpatentable over claims 1 – 24 of copending Application USSN 10/800,250. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is no manipulative difference between the methods claimed in the two applications.

Applicant argues that this rejection should be withdrawn on the grounds that it is the only rejection remaining in the instant application.

In response, it is acknowledged that this rejection will be removed if it becomes the only remaining rejection in this application, the instant application being an earlier-filed application relative to USSN 10/800,250. In view of the remaining outstanding rejections against the instant claims, the rejection of record is maintained for the reasons of record, as it applies to the amended claims. The rejection of record is incorporated by reference herein, as if reiterated in full.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Applicant's Statement under 37 CFR 1.78(c), regarding common ownership of the instant application and USSN 10/800,250 at the time the invention was made, is acknowledged.

7. Conclusion: no claim is allowed.

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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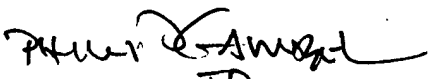
published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

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December 27, 2006


PHILLIP GAMBEL, Ph.D. JD
PRIMARY EXAMINER
TR 1600
12/27/06